

## **REMARKS**

### **I. General Remarks**

Please reconsider the application in view the following remarks. Applicants thank the Examiner for carefully considering this application.

### **II. Disposition of Claims**

Claims 1-22, 27, and 30 are pending in this application. Claims 23-26 and claims 28-29 are hereby cancelled; no amendment to inventorship is necessitated by this cancellation. Claims 1, 9, 16, 27, and 30 are independent and all remaining claims depend, either directly or indirectly, from one of those claims.

### **III. Rejection of Claims under 35 U.S.C. § 102**

#### **A. Rejections under *Smith*.**

Pending claims 1-2, 4, 9, 11, 16, and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,224,546 to Smith *et al.* (“*Smith*”), this rejection is respectfully traversed.

To form a basis for a § 102(b) rejection, a prior art reference must disclose each and every element as set forth in the claim. *See* MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). However, *Smith* does not disclose the methods as recited by independent claims 1, 9, and 16. Specifically, *Smith* does not disclose the step of allowing the servicing fluid’s pH to reduce. As the Examiner notes, the methods of reducing the viscosity of a fluid disclosed in *Smith* involve (1) the degradation of polymer chains in the fluid by an acid, and (2) the removal of the metal ion from a crosslinked polymer by a metal-ion chelator. *See Smith* at col. 1, lines 64-68, col. 2, lines 1-2. Neither of these methods discloses a reduction of the pH of the fluid. Although the Examiner asserts that “the acid generated from the decomposable materials will, of course, have a lowering effect on the pH of the system,” this is not necessarily the case since *Smith* also discloses the use of a pH adjusting material that could counteract any reduction of the pH of the system by the acid produced. *See* Office Action at ¶ 2; *Smith* at col. 3, line 59-68, col. 4, lines 1-3.

In view of the above, *Smith* fails to disclose all of the elements in independent claims 1, 9, and 16; thus, independent claims 1, 9, and 16 are patentable over *Smith*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the

limitations of the claim to which it refers,” and since dependent claims 2, 4, 11, and 18 depend, either directly or indirectly, from one of claims 1, 9, or 16, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, withdrawal of this rejection is respectfully requested.

**B. Rejections under *Dawson*.**

Pending claims 1-4, 7, 9-11, 14, and 16-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,793,018 to Dawson *et al.* (“*Dawson*”), this rejection is respectfully traversed.

To form a basis for a § 102(e) rejection, the prior art reference must disclose each and every element as set forth in the claim. *See* MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). However, *Dawson* does not disclose the methods as recited by claims 1, 9, and 16. Specifically, like *Smith*, *Dawson* does not disclose the step of allowing the servicing fluid’s pH to reduce. *Dawson* fails to disclose any effect of the methods disclosed therein on the pH of a fluid. Nor does *Dawson* disclose any method of acid production that might effect a reduction in the pH of the fluid.

In view of the above, *Dawson* fails to disclose all of the elements in independent claims 1, 9, and 16; thus, independent claims 1, 9, and 16 are patentable over *Smith*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since dependent claims 2-4, 7, 10-11, 14 and 17-18 depend, either directly or indirectly, from one of claims 1, 9, or 16, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, withdrawal of this rejection is respectfully requested.

**C. Harris does not disclose the present invention as claimed.**

Pending claims 1-4, and 9-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,813,466 to Harris *et al.* (“*Harris*”), this rejection is respectfully traversed.

As previously indicated, to form a basis for a § 102(b) rejection, a prior art reference must disclose each and every element as set forth in the claim. However, *Harris* does not disclose the methods as recited by claims 1, 9, and 16. *Harris* does disclose the use of a

“substrate which is capable of being converted by [an] enzyme into an organic acid”; however, *Harris* does not disclose the use of this acid-releasing substrate without the need for an enzyme to catalyze the reaction. In contrast, the acid releasing material in the methods of the present application may, *inter alia*, act alone to reduce the pH of the servicing fluid that comprises it. Therefore, any methods disclosed in *Harris* that might reduce the pH of a fluid are fundamentally different from those claimed in the present application because they require the use of an enzyme (in addition to the substrate that actually releases the acid) to perform the step of reducing the pH of the fluid.

In view of the above *Harris* fails to disclose all of the elements in independent claims 1 and 9; thus, claims 1 and 9 are patentable over *Harris*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since dependent claims 2-4 and 10-11 depend, either directly or indirectly, from one of claims 1 or 9, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, withdrawal of this rejection is respectfully requested.

#### **IV. Objections to Claims**

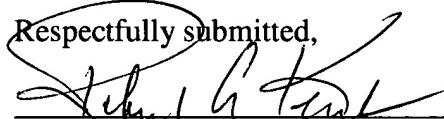
Pending claims 5-6, 8, 12-13, 15, 19-20, 22, 27, and 30 are objected to as being dependent upon rejected base claims. Pending claims 5-6, 8, 12-13, 15, 19-20 and 22 each depend, either directly or indirectly, from one of claims 1, 9, or 16. As the rejections of claims 1, 9, and 16 have been traversed herein, withdrawal of the objections to dependent claims 5-6, 8, 12-13, 15, 19-20 and 22 is respectfully requested. Claims 27 and 30 have been rewritten in independent form to include all the limitations of the base claim and all intervening claims; hence, withdrawal of the objection to claims 27 and 30 is respectfully requested.

#### **SUMMARY**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections and objections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the

prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants hereby authorize the Commissioner to charge \$200 as a fee for an additional independent claim over those filed with the original application to Deposit Account No. 08-0300 (Reference Number HES 2001-IP-005443U2). Should the Commissioner deem that any additional fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a petition therefore, and direct that any additional fees be charged to Deposit Account No. 08-0300 (Reference Number HES 2001-IP-005443U2).

Respectfully submitted,  


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Date: February 4, 2005